

### **REMARKS**

The title and the abstract have been amended. No claim amendments are provided with this response. Claims 27-29 and 32-52 are currently pending in this application. Entry of the amendments, and reexamination and reconsideration of the application is respectfully requested.

The title and the abstract have been amended to reflect more accurately the claimed invention. The invention specified in claims 27-29 and 32-52 is not limited to an adhesive article which provides air egress, but rather relates to an adhesive article which provides one or more of air egress, repositionability and slideability for easy application to a substrate; see, paragraphs [0008] and [0019] of the Applicant's specification. The amended title and abstract take this into account.

The Applicant acknowledges with thanks the Examiner's finding that Applicant's argument "Although claim 27 is broad, it is fully enabled, and thus need not be narrowed" is persuasive.

Claim 28 has been objected to on the grounds that it specifies a range of about 30 nanometers to about 100 microns which is inconsistent with the disclosure in the specification. Applicant respectfully disagrees.

In the previous response, Applicant pointed out that claim 28 is an original claim and therefore is part of the original disclosure. Paragraph [0035] was amended to incorporate the subject matter of claim 28 into the specification. On page 3 of the instant office action the Examiner acknowledges that this amendment was made. Applicant respectfully submits that paragraph [0035], as amended, is consistent with and fully supports claim 28.

The Examiner cites 35 USC §112, first paragraph, and states that the specification should be revised carefully to comply with the statute. Applicant respectfully submits that the amendment to paragraph [0035] in the last response was in full compliance with 35 USC §112, first paragraph. Claim 28 was part of the original disclosure and copying its contents into the specification is permissible under the statute.

Paragraph [0038] of the specification supports claim 28. Paragraph [0038] states:

“In one embodiment, the non-adhesive layer is a printing ink having a thickness from about 0.3 to about 100 microns, from about 0.5 to about 50 microns, or from about 2 to about 20 microns. The non-adhesive material may also be applied to the pressure sensitive adhesive by means of patterned vacuum metallization or sputtering. In this embodiment, the non-adhesive layer typically has a thickness from about 30 to about 3000, from about 100 to about 2000, or from about 300 to about 1500 nanometers.”

Paragraph [0038] clearly discloses that the non-adhesive material forms may have thicknesses as low as about 30 nanometers and as high as about 100 microns. Thus, claim 28, which specifies that the non-adhesive material forms have an average thickness of about 30 nanometers to about 100 microns, is clearly supported by paragraph [0038].

Withdrawal of the objection to claim 28 is believed to be warranted and is respectfully requested.

Claim 28 has been rejected under 35 USC §112, first paragraph, on the grounds that the specification “does not reasonably provide enablement for a thin coating of 0.03  $\mu$  (30 micrometers).” Applicant presumes that the Examiner meant 30 nanometers rather than 30 micrometers. This rejection is respectfully traversed.

In the Office Action the Examiner states “its [claim 28] recited thickness of 30 nanometers appears to be too thin to be enabled for an effective non-adhesive material form.” The Examiner then goes on to state that the “Applicant is required to provide an evidentiary support to show that a thin coating of only 30 nanometers is reasonably enabled for the intended use of the instant invention, or an appropriate correction is again requested.” Applicant respectfully disagrees.

Paragraph [0038] of the Applicant's specification states that the non-adhesive material forms having thickness as low as 30 nanometers can be applied “by means of patterned vacuum metalization or sputtering.” Applicant respectfully submits that this constitutes an enabling disclosure for the non-adhesive material forms having thickness as low as 30 nanometers.

The Examiner makes the following statement, which it is respectfully submitted is based on assumptions that amount to nothing more than pure speculation:

Additionally, the Examiner would like to point out that according to the periodic table, the diameter of carbon atom is 1.82 (see article at <http://hyperphysics.phy-astr.gsu.edu/hbase/pertab/c.html#c1>), so a thickness of 30 nanometers (300 Å) is only approximately equivalent to 182 carbons stacked in a straight line side-by-side. Since the non-adhesive material form is made from a curable link of polymeric materials (paragraph 0017), which typically contain thousands of carbon atoms each polymer molecule, it appears to the Examiner that a thickness of 30 nanometers unreasonably requires the thickness of a cured non-adhesive material to be in the molecular thickness range or less.

If the Examiner intends to rely on the foregoing statement as fact, Applicant respectfully requests that the Examiner provide more evidence than mere citation to the Periodic Table. The Examiner is requested to provide a citation to prior art or an affidavit supporting the foregoing statement or withdraw the statement.

The Examiner has the burden to establish a reasonable basis to question the enablement provided for a claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). See also, MPEP § 2164.04:

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (Emphasis added, see also *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971)).

The Examiner has failed to meet this burden. Applicant respectfully submits that no reasonable statement of fact or prior art reference has been supplied to doubt the teachings in the Applicant's specification. Therefore, the teaching of patterned sputtering and vacuum metallization provided in the Applicant's specification must be regarded as sufficient to comply with the enablement requirement of 35 USC § 112.

Withdrawal of the rejection of claim 28 under 35 USC §112, first paragraph, is believed to be warranted and is respectfully requested.

Claims 27-29 and 32-52 have been rejected under 35 USC § 112, first paragraph. The Examiner contends that “[A] pattern of non-adhesive material providing a path for air egress from adhesive article is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.” This rejection is respectfully traversed.

In paragraph [0008], the Applicant's specification states (emphasis added):

[0008] This invention relates to an adhesive article which provides air egress. Air egress is provided by supplying at least one route, such as areas of no initial adhesion for the air to flow out from under the construction. The invention relates to an adhesive article comprising a facestock having a front surface and a back surface, a continuous layer of adhesive having an upper surface and a lower surface, wherein the upper surface of the adhesive layer is adhered to the back surface of the facestock, and a pattern of non-adhesive material forms that are in embedded into the lower or upper surface of the adhesive layer. The invention further relates to methods of preparing the adhesive articles. These articles have usefulness as industrial graphics images, as well as decorative coverings, etc. The articles provide one or more of air egress, repositionability and slideability.

This is consistent with paragraph [0019] which states: “The adhesive articles provide one or more of air egress, repositionability and slidability for easy application to a substrate.” Air egress is one of several features provided by the Applicant's claimed adhesive articles. Air egress is neither critical nor essential. The “one or more of” phrase used in paragraphs [0008] and [0019] may be satisfied by the exclusion of air egress, making air egress not only not critical, but unnecessary.

Applicant thus respectfully submits that the characterization of air egress by the Examiner as “critical or essential” is contrary to the teachings in the Applicant's specification. The following passage from the MPEP supports the Applicant's position that the statements in the specification that the adhesive articles provide one or more of air aggress, repositionability and slideability are sufficient to rebut the argument of criticality:

In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976). Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality. (MPEP 2164.08(C)).

The Examiner relies on the portion of the original Abstract that stated "an adhesive article which provides air egress." However, the Applicant has replaced the original Abstract. The new Abstract does not contain the language quoted by the Examiner.

The Examiner's comments concerning "cancelled claims 53-95" are not relevant to the question of whether claims 27-29 and 32-52 are enabled. Applicant respectfully submits that 35 U.S.C. §112, first paragraph, requires nothing more than objective enablement. Whether this is achieved by use of illustrative examples or broad terminology is of no importance. As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. § 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). See also, for example, *In re Marzocchi et al, supra*.

Applicant respectfully submits that an enabling disclosure is provided in the present specification that is sufficient to support claims 27-29 and 32-52 and, thus, the claims need not be narrowed.

Withdrawal of the rejection of claims 27-29 and 32-52 under 35 USC §112, first paragraph, is believed to be warranted and is respectfully requested.

### **Conclusion**

A notice of allowance is respectfully solicited. In the alternative, entry of the amendment is requested for purposes of an appeal. If it is determined that unresolved

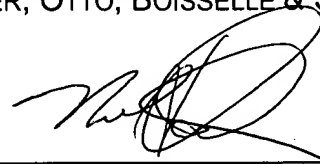
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issues remain, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the application.

In the event any additional fees are due in connection with the filing of this paper, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 (Reference: AVERP2850USB).

Respectfully submitted,  
RENNER, OTTO, BOISSELLE & SKLAR, LLP

By



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